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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,730	05/23/2000	David Creemer	PAILM-2976.US.P	4739

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EXAMINER

WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
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2155

12

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,730

Applicant(s)

CREEMER, DAVID

Examiner

Liang-che Alex Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-16 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-16 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 5-16, 22-29 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-16, 22-25, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over in combination of Abdous et al, US Patent Number 5,577,210, herein after Abdous, US Patent Number 6,405,218, and Schwitters et al. US Patent Number 6,526,413, Hereinafter Schwitters, and Applicant Admitted Prior Art (Figure 1), hereinafter AAPA, in further view of Boothby, US Patent Number 6,405,218, hereinafter Boothby. . .
4. Referring to claim 5, Abdous has taught a method of restoring basic functionality to a device (see title) comprising the steps of:
 - a. making a connection between a bootstrap server and a portable computer system (item 1, figure 1, and Col 2 lines 3-4) and a terminal computer system (item 21);
 - b. synchronizing said bootstrap server with said terminal computer system (Col 2 lines 9-11, when the data in the server side is being recopied into an image file and send to a terminal is considered as synchronizing) by other than a cradle device (server is the device other than a cradle device being synchronizing with the terminal computer system), wherein said server uses synchronization software

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which is compatible with a core set of communication functions stored in said portable computer's non-volatile memory (a digital terminal required software in the non-volatile in order to communicate with the server, without this core set of communication function. The terminal is only a non operational object;) that is adapted to synchronize said terminal computer system to a desktop computer system (Col 2 lines 3-15, server 1 is viewed as the desktop computer system);

- c. transferring first software from said bootstrap server to a volatile memory unit of said terminal computer system (Col 2 lines 3-14, Abdous taught a method for remote booting by a server of at least one terminal. In order for a server to remotely boots a terminal, a set of code is being transferred from the bootstrap server to the volatile memory unit of said terminal computer system, support can also be found in the previous actions);

Abdous has not taught an enterprise server operable to connect to said terminal computer system, wherein said terminal computer system and said enterprise server communicate and transfer information with said terminal computer system using said extended set of communication.

However, Schwitters has taught enterprise server (item 24 figure 1) operable to connect to a personal digital assistant (item 22 figure 1), wherein said personal digital assistant and said enterprise server communicate and transfer information with said personal digital assistant using a extended set of communication (a software is required for server and PDA to communicate.).

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It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's terminal computer system to be a portable computer system which is able connected to a enterprise server, which is operable to connect to Abdous's terminal, wherein said terminal and said enterprise server communicate and transfer information with said terminal using a extended set of communication as described by Schwitters,

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because PDA requires a set of communication functions in order to communicate with the enterprise server, and the bootstrap server of Abdous is transferring data to the PDA, a person with ordinary skill in the art would realized that the required data to communicate between PDA and enterprise server could also be saved in the bootstrap server to backup the data or software required to communicate between PDA and enterprise server.

Furthermore, Abdous as modified has taught the synchronization communication between a PDA and a server. Abdous as modified has not explicitly taught that the synchronization is done via a cradle device.

However, AAPA has disclosed in Figure 1 as a prior art that the communication between a PDA and desktop is done via a cradle device.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have the PDA and the server computer system to communicate with each other via a cradle device, because applicant has admitted that communication via a cradle device is known as the prior art. When applicant states that something is

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prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 509 F.2d 566, 184 USPQ 607, *611 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.). see MPEP 2129.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because communication via a cradle device is known as a prior art in communication between a PDA and a computer system, and having a cradle device would allow the system to have an intermediary between the PDA and the computer system which is providing an interface to both side of communications.

5. Referring to claim 6, Abdous has further taught wherein step c) comprises the step of:
c1) transferring an extended set of communication functions from said bootstrap server to said portable computer system (Col 2 lines 3-14, Abdous taught a method for remote booting by a server of at least one terminal, the process of booting is transferring a extended set of communication functions.)
6. Referring to claim 7, Abdous has further taught wherein said bootstrap server and said portable computer system are operable to communicate via a Ethernet connection (Col 3 lines 54-56)

Abdous has not taught the communication via a telephone line. However, Boothby has taught the communication between the server and portable computer system could be connected via a telephone lines (Col 5 lines 30-37).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous's bootstrap server and terminal to communicate via a telephone line.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous because bootstrap server and the terminal of Abdous requires a connection means for communication and Boothby provides a variety of connection means for server and remote computers to connects. It would be obvious for Abdous to use Boothby's connection means including telephone lines to adapt more communication methods.

7. Referring to claim 8, Abdous combined with Schwitters has taught an invention as described in claim 5. Abdous combined with Schwitters has not taught wherein said data was backed up on said enterprise server from a pervious synchronization between said enterprise server and said portable computer system.

However, Boothby has taught synchronizing the records of the local and remote databases by using a history file ... which records have been changed, since the previous synchronized and which records of the two databases correspond to one another (Col 5 lines 43-51).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Schwitters's data backed up on its server from a pervious synchronization between said server and said portable computer system.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous and Schwitters because having the memory in both portal

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computer and the enterprise server synchronized would allow two systems to be more compatible to each other (Col 1 lines 40-54).

8. Referring to claim 9, Abdous has further taught wherein said portable computer system is a personal digital assistant (Item 21 figure 1, Col 2 lines 3-4, at least one terminal, this electronic terminal which is a digital device that help a person to organized or computing data could be named a personal digital assistant.)
9. Referring to claim 10, Abdous combined with Schwitters has taught an invention as described in claim 5, Schwitters has further taught wherein said personal digital assistant communicates with said enterprise server over the Internet (see Figure 1 item 24);
10. Referring to claims 11-16, claims 11-16 encompass the same scope of the invention as that of the claims 5-10. Therefore, claims 11-16 are rejected for the same reason as the claims 5-10.
11. Referring to claim 22-25, 28-29, claims 22-25, 28-29 encompass the same scope of the invention as that of the claims 1, 6-8. Therefore, claims 22-25, 28-29 are rejected for the same reason as the claims 1, 6-8.
12. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abdous Schwitters, AAPA and Boothby and in further view of Fawcett, US Patent Number 6,327,617, hereinafter Fawcett.
13. Referring to claims 26 and 27, Abdous as modified has taught an invention as described in claim 22, and Abdous as modified has not explicitly taught a method of sending a menu of software to said portable electronic device and, receiving from said portable

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electronic device, a selection of software to be installed on said portable electronic devices.

However, Fawcett has taught a method for obtaining computer software from a remote computer comprising means for sending software to remote customer by selection of computer software from the list of computer software available for installation on the remote customer (see title and Col 13 line 64- Col 14 line 4.)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have Abdous as modified's portable electronic device receiving a menu of software and the receiving from said portable electronic device, a selection of software to be installed on said portable electronic devices, because both Abdous and Fawcett has taught inventions relating to transmitting and receiving data in a communication system.

A person with ordinary skill in the art would have been motivated to make the modification to Abdous as modified because having such a list for remote customer, would allow user to update his portable device when his portable device does not have a particular software (Col 2 line 39- Col 3 line 62.)

Response to Arguments

14. Applicant's arguments with respect to claims 5-16, 22-29, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).
16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-8159. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications.
20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Liang-che Alex Wang *lw*
March 17, 2004

Hosain Alam
HOSAIN ALAM
SUPERVISORY PATENT EXAMINER